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In re Application of  
ALPEROVICH, Mark, et al.  
U.S. Application No.: 09/530,114  
PCT No.: PCT/US98/23625  
International Filing Date: 06 November 1998  
Priority Date: 07 November 1997  
Attorney's Docket No.: 109289.00138  
For: FLUORESCENT COMPOSITION FOR  
THE MANUFACTURE OF CD-ROM  
TYPE OPTICAL MEMORY DISKS

DECISION ON  
PETITION UNDER  
37 CFR 1.47(a)

This decision is issued in response to the "Petition Under 37 CFR 1.47(a)" filed on 18 September 2000. Applicants have been charged the required petition fee.

**BACKGROUND**

On 06 November 1998, applicants filed international application PCT/US98/23625 which claimed a priority date of 07 November 1997 and which designated the United States.

On 07 June 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 08 May 2000 (07 May 2000 was a Sunday).

On 25 April 2000, applicants filed a transmittal letter for entry into the national stage in the United States which indicates that it was accompanied by, among other materials, a check in the amount of \$986 (\$670 as the basic national fee, \$130 as the surcharge for filing the declaration after the thirty month deadline, \$108 for inclusion of six extra claims, and \$78 for inclusion of one extra independent claim). A copy of the international application was not required because the international application had been filed in the United States Receiving Office.

On 19 June 2000, the United States Designated/Elected Office (DO/EO/US) mailed a

Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The Notification also informed applicants that the failure to submit this declaration within one month of the date of the Notification would result in abandonment of the application.

On 18 September 2000, applicants filed the "Petition Under 37 CFR 1.47(a)" accompanied by, among other materials: (1) a Declaration Of Alexander Libin regarding the circumstances of the nonsigning inventors' refusal to execute the application papers, and (2) a declaration executed by inventors Mark Alperovich, Eugene Levich, and Irene Zuhl, but not by co-inventors Boris Glushko and Vladimir Krupkin. The Petition was accompanied by a request for a two month extension of time to respond and a check for the \$190 small entity fee for the two month extension. Based on this extension, the present petition is considered a timely response to the Notification Of Missing Requirements mailed on 19 June 2000. In addition, based on the authorization in the petition, Deposit Account No. 23-2185 has been charged \$130 as the petition fee.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(I), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As set forth below, applicants here have satisfied items (1), (2) and (4); however, they have failed to satisfy item (3).

Regarding items (1) and (2), applicants have been charged \$130 payment for the petition fee, and the petition included a statement of the nonsigning co-inventors' last known addresses. Thus, items (1) and (2) are satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration submitted contains an unsigned signature block for the nonsigning co-inventors, Boris Glushko and Vladimir Krupkin, and it is executed by the other co-inventors, Mark Alperovich, Eugene Levich, and Irene Zuhl. Thus, the declaration can be treated as

having been executed by the available inventors on behalf of the nonsigning inventors. However, the declaration identifies the last inventor as Irene Zuhl. This inventor is identified as Irene Sul in the published international application. The declaration submitted therefore fails to satisfy the requirements of 37 CFR 1.497(a) and (b) in that it fails to properly identify the inventors. It is possible that the discrepancy can be explained as a simple typographical error. However, because applicants have not stated that this is the case and have not confirmed which of the two spellings is correct, the declaration cannot be accepted at this time. Applicants must submit a corrected declaration or, if the inventor's correct name is Zuhl, as set forth in the filed declaration, than applicants must provide a statement to that effect and, if factually appropriate, a statement that the discrepancy in the names was the result of a typographical error (if the discrepancy resulted from an actual change of the inventor's name, than a proper petition must be filed; see MPEP § 605.04(c)). Based on the above, item (3) has not been satisfied. In addition, it is noted that the filing date of the international application is improperly identified as 25 April 2000 (the date on which the national stage application was initiated) rather than the correct date of 06 November 1998, as indicated in the international publication. A revised version of the declaration in which this date is corrected is required before further processing of the application can proceed.

As for item (4), applicants have submitted the Declaration Of Alexander Libin and exhibits thereto as evidence of the nonsigning inventors' refusal to execute the application documents. Paragraph three of Dr. Libin's declaration and Exhibits E and F thereto demonstrate that a complete copy of the application papers, including "the specification and drawings," were sent to the nonsigning inventors by Dr. Libin. Paragraph five of the declaration describes the express refusal of Boris Glushko to execute the application papers, which was made directly to Dr. Libin. As for Dr. Krupkin, Dr. Libin states that he has consistently refused to execute applications in the past. This statement, coupled with the evidence provided that Dr. Krupkin has twice been sent materials to execute for the present application but has failed to do so, is sufficient evidence that Dr. Krupkin has refused to execute the present application. Applicants have therefore provided the firsthand factual evidence required under section 409.03(d) of the MPEP to demonstrate the refusal to execute application documents by the two nonsigning co-inventors here. Item (4) is satisfied.

Because applicants have failed to satisfy all the requirements for a grantable petition under 37 CFR 1.47(a), the declaration filed on 18 September 2000 may not be accepted at the present time.

### CONCLUSION

The "Petition Under 37 CFR 1.47(a)" is **DISMISSED** without prejudice.

Deposit Account No. 23-2185 has been charged the \$130 petition fee.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include, as discussed above: (1) a corrected declaration which identifies the last inventor by the same name as set forth in the international application (Irene Sul), or (2) if the inventor's correct name is Zuhl, as set forth in the filed declaration, than applicants must provide a statement or petition, as discussed above.

Applicants must also submit a revised declaration in which the filing date for the international application executed by the declaration has been corrected.

**Failure to file a proper response within the time limit set forth will result in abandonment of the international application as to the national stage in the United States.**

Please address further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and direct the contents of the letter to the attention of the PCT Legal Office.



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